

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

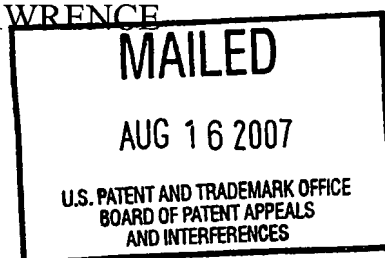
---

*Ex parte* CHRIS A. BARTON,  
JAMES M. VIGNOLES and JAMES W. LAWRENCE

---

Application 09/916,600  
Appeal No. 2007-3615

---



---

ORDER REMANDING APPEAL TO EXAMINER

---

This application was electronically received at the Board of Patent Appeals and Interferences on June 20, 2007. A docketing notice was mailed and Appeal No. 2007-3615 was assigned on June 27, 2007. A review of the application has revealed that the application was not ready for an appeal. Accordingly, the application is herewith being remanded to the Examiner. The matter requiring attention is identified below.

BACKGROUND

AMENDMENT

An amendment was filed January 28, 2005. This amendment included the cancellation of claims 3, 8, 9, 19, 24, 25 and adding claims 40-42. This amendment was entered by Examiner in the Final Rejection dated March 22, 2005.

Application 09/916,600  
Appeal No. 2007-3615

## AMENDMENT AFTER FINAL

An amendment was filed April 28, 2005. This Amendment included the cancellation of claim 13. The Amendment after final was denied entry by the Examiner in an Advisory Action dated May 15, 2005.

## APPEAL BRIEF

Appellant filed a Substitute Appeal Brief dated October 5, 2006, in response to the Notice of Appeal Brief Non-Compliance mailed September 5, 2006. The Substitute Appeal Brief is not in compliance with the new rules of 37 CFR § 41.37(c) effective September 13, 2004.

(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

(2) The brief must be accompanied by the fee set forth in § 41.20(b)(2).

(b) On failure to file the brief, accompanied by the requisite fee, within the period specified in paragraph (a) of this section, the appeal with stand dismissed.

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(iii) *Status of claims*. A statement of the status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of those claims that are being appealed.

Application 09/916,600  
Appeal No. 2007-3615

(vi) ***Grounds of rejection to be reviewed on appeal.*** A concise statement of each ground of rejection presented for review.

(vii) ***Argument.*** The contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown. Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Not with-standing any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for patentability of the claim.

(viii) ***Claims appendix.*** An appendix containing a copy of the claims involved in the appeal.

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or with any appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of the appeal.(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

An in-depth review of the Appeal Brief indicates that the following sections are defective in the Substitute Appeal Brief filed October 5, 2006:

1) “Status of claims”, as set forth in 37 C.F.R. § 41.37(c)(1)(iii);

Application 09/916,600  
Appeal No. 2007-3615

Claim 13 was identified as cancelled. It is noted that Claim 13 remains pending and under rejection.

- 2) "Grounds of rejection to be reviewed on appeal", as set forth in 37 C.F.R. § 41.37(c)(1)(vi);

Issue #2: Appellant identified that claims 1-40 are rejected under 35 U.S.C. 103(a). However, it is noted that claims 3, 8, 9, 19, 24 and 25 were cancelled in the Amendment dated January 28, 2005.

- 3) "Argument." 37 C.F.R. § 41.37(c)(1)(vii);

Page 4, paragraph 4, indicates that appellant incorporates original claim 3 into part d) above and original claims 8 and 9; all identified claims which have been cancelled.

- 4) "Claims Appendix," as set forth in 37 C.F.R. § 41.37(c)(1)(viii);

The Claims Appendix indicates that Claim 13 was cancelled.

It is required that a substitute brief be submitted that is in compliance with 37 C.F.R. § 41.37(c).

**SUBSTITUTE EXAMINER'S ANSWER**

On January 24, 2007, a Substitute Examiner's Answer was mailed.

A review of the Substitute Examiner's Answer reveals that is not in compliance with the headings as set forth in the new rules under 37 C.F.R. 41.37(c):

- 1) "Status of claims", as set forth in 37 CFR § 41.37(c)(1)(iii);

The Examiner indicates that the status of claims contained in the brief is correct. It should be noted that Claim 13 appears to remain a pending, rejected claim.

- 2) "Grounds of rejection to be reviewed on appeal", as set forth in 37 CFR § 41.37(c)(1)(vi);

The Examiner indicates that claims 1-40 are rejected under 35 U.S.C. 103(a). However, it is noted that claims 3, 8, 9, 19, 24 and 25 were

Application 09/916,600  
Appeal No. 2007-3615

cancelled in the Amendment dated January 28, 2005.

3) "Argument." 37 C.F.R. § 41.37(c)(1)(vii);

In Section 9, (lines. 11-12, pg. 4) the Examiner references cancelled claim 3  
8 and 9.

4) "Claims Appendix," as set forth in 37 CFR § 41.37(c)(1)(viii);

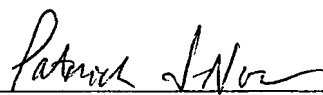
The Examiner indicates that the copy of the appealed claims contained in the  
Appendix to the brief is correct. Note that Claim 13 was identified as cancelled,  
however, claims appears to be pending and rejected.

**CONCLUSION**

Accordingly, it is

**ORDERED** that the application is returned to the examiner to:

- 1) hold the Substitute Appeal Brief of October 5, 2006, defective;
- 2) notify applicants to file a substitute Appeal Brief in compliance with 37 CFR 41.37;
- 3) consider the substitute Appeal Brief;
- 4) vacate the Substitute Examiner's Answer dated January 24, 2007,
- 5) prepare a revised Examiner's Answer to include all appropriate headings in accordance  
with the new rules effective September 13, 2004; and
- 6) for such further action as may be appropriate.

By:   
PATRICK J. NOLAN  
Deputy Chief Appeals Administrator  
(571) 272-9797

Application 09/916,600  
Appeal No. 2007-3615

PJN/jgr

ZILKA-KOTAB PC  
P O BOX 721120  
SAN JOSE CA 95172-1120